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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,529	10/31/2003	Robert H. Wollenberg	T-6298 (538-59)	2770

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EXAMINER

WALLENHORST, MAUREEN

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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12/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,529

Applicant(s)

WOLLENBERG ET AL.

Examiner

Maureen M. Wallenhorst

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 1, 2007 has been entered.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 and 18-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added limitation to independent claims 1 and 20 concerning the plurality of different lubricating oil compositions having a phosphorous content at or below 0.08 wt.% and a sulfur content below 0.2 wt.% is new matter because nowhere in the specification, as originally

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filed, is it taught that each of the different lubricating oil compositions in the library each have these levels of phosphorous and sulfur therein. The only place in the specification where the phosphorous and sulfur content of lubricating oil compositions is mentioned is on page 2 where it is described how the U.S. Military Standards MIL-L-46152E and the ILSAC Standards defined by the Japanese and U.S. Automobile Industry Association have **proposed** that the phosphorous content be lowered to 0.08 wt% by January 2004 and below 0.05 wt.% by January 2006, and that the sulfur content be lowered to below 0.2 wt.% by January 2006. However, there is no indication in the specification that the lubricating oil compositions actually present in the combinatorial library have these low levels of phosphorus and sulfur, especially since the standards set forth by the Japanese and U.S. Automobile Industry Association are only proposals, not actual laws to be enforced. In addition, since this application was filed on October 31, 2003 before the dates mentioned by the standards of the Japanese and U.S. Automobile Industry Association on page 2 of the specification (i.e. January 2004 and January 2006), there is no presumption that the lubricating oil compositions in the combinatorial library of the instant application filed before January 2004 and January 2006 have a phosphorous content of at or below 0.08 wt.% and a sulfur content below 0.2 wt.%, as now recited in the claims. For these reasons, claims 1-16 and 18-32 contain new matter not supported by the specification as originally filed.

5. Claims 1-16 and 18-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite since it recites a combinatorial lubricating oil composition library only comprising property data for a plurality of different lubricating oil compositions without positively reciting the different lubricating oil compositions themselves as a component of the library. In order for the data to make proper sense in terms of a "combinatorial library", the different lubricating oil compositions must be positively recited as a component of the library. Therefore, it is requested that claim 1 be amended by deleting the phrase "lubricating oil composition property data for" on line 2, and at the end of the claim, inserting the phrase --, and lubricating oil composition property data for said plurality of different lubricating oil compositions-- after the period. See this same problem in independent claim 33.

On line 3 of claim 34, the phrase "the piston ring" lacks antecedent basis. On line 4 of claim 34, the phrases "the piston" and "the upper dead center" lack antecedent basis. On lines 4-5 of claim 34, the phrase "the force of the fuel combustion explosion" lacks antecedent basis. Claim 34 is indefinite since it is not clear what process is being referred to as the "extreme wear condition".

On lines 3-4 of claim 35, the phrase "the piston rings and cylinder wall" lacks antecedent basis. On line 4 of claim 35, the phrases "the piston" and "the stroke" lack antecedent basis. Claim 35 is indefinite since it is not clear what process is being referred to as the "hydrodynamic lubricant condition".

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 20 and 22-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13-14 and 21 of copending Application No. 10/699,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a method for producing a combinatorial library of different lubricating oil compositions by combining a major amount of a base oil of lubricating viscosity with a minor amount of an oil additive to form a plurality of lubricating oil composition samples, and placing the samples in a plurality of test reservoirs. In addition, both sets of claims recite analyzing the lubricating oil composition samples for property data. Since the same type of lubricating oil compositions (i.e. engine oils, marine oils, etc) are included in the combinatorial library of this application and application serial no. 10/699,510, it is presumed that the phosphorous and sulfur content of the compositions in both applications are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 20 and 22-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 13-18, 20-22 and 33-38 of copending Application No. 10/699,507. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a method for

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producing and screening lubricating oil additive compositions comprising the steps of providing a plurality of lubricating oil additive compositions, each containing a major amount of a base oil of lubricating viscosity and a minor amount of an oil additive, measuring composition property data such as the storage stability of the samples, and outputting the results. Since the same type of lubricating oil compositions (i.e. engine oils, marine oils, etc) are included in the combinatorial library of this application and application serial no. 10/699,507, it is presumed that the phosphorous and sulfur content of the compositions in both applications are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 20, 22-24 and 26-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 10-14 of copending Application No. 10/699,508. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a method for producing and screening lubricating oil additive compositions comprising the steps of providing a plurality of lubricating oil additive compositions, each containing a major amount of a base oil of lubricating viscosity and a minor amount of an oil additive, measuring composition property data such as the oxidation stability of the samples, and outputting the results. Since the same type of lubricating oil compositions (i.e. engine oils, marine oils, etc) are included in the combinatorial library of this application and application serial no. 10/699,508, it is presumed that the phosphorous and sulfur content of the compositions in both applications are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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10. Claims 1, 17-18 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 34 of copending Application No. 10/779,422. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a combinatorial lubricating oil composition library comprising a plurality of different lubricating oil compositions, each containing a major amount of a base oil of lubricating viscosity and a minor amount of an oil additive, and property data of the compositions such as deposit formation. Since the same type of lubricating oil compositions (i.e. engine oils, marine oils, etc) are included in the combinatorial library of this application and application serial no. 10/779,422, it is presumed that the property data in the libraries of both applications are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Applicant's arguments filed November 1, 2007 have been fully considered but they are not persuasive.

The previous provisional rejections of the claims under the judicially created doctrine of obviousness-type double patenting made in the Office action mailed on September 5, 2007 are maintained since Applicants have not sufficiently amended the claims nor filed the appropriate terminal disclaimers in order to overcome these rejections.

The previous rejection of the claims under 35 USC 102 as being anticipated by Kolosov et al, and the previous rejections of the claims under 35 USC 103 as being obvious over Kolosov et al or over Kolosov et al in view of Smrcka et al have been withdrawn in view of Applicants' amendments to the claims. However, as noted above, the amended claims are now rejected

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under 35 USC 112, first paragraph for the inclusion of new matter therein. If the new matter were to be deleted in a further amendment by Applicants, the rejections under 35 USC 102 and 35 USC 103 would be reinstituted since the claims, without the inclusion of the new matter material concerning the content of phosphorous and sulfur in the lubricating oil compositions, are properly rejectable over Kolosov et al and Smrcka et al for the reasons of record in the Office action mailed on September 5, 2007.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen M. Wallenhorst whose telephone number is 571-272-1266. The examiner can normally be reached on Monday-Thursday from 6:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maureen M. Wallenhorst
Primary Examiner
Art Unit 1797

mmw

November 27, 2007

Maureen M. Wallenhorst
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